

**Notice of Allowability**

Application No.

10/719,075

Examiner

Marc S. Zimmer

Applicant(s)

KLEINEBERG ET AL.

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/21/03.
2. ☒ The allowed claim(s) is/are 1-13.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 11/21/03
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

***Allowable Subject Matter***

The Examiner located the following references that teach comparable inventions but, nonetheless, fail to anticipate or render obvious the instantly claimed invention:

*Hellwig et al.* U.S. Patent # 6,503,981

Hellwig discloses a polyurethane hot melt adhesive comprising all of (1), (3), (4), (5), and the isocyanate reactive compound. Rather than teaching a separate blocking agent, the reference discloses that blocked diisocyanates may be employed in the formation of the adhesive. However, it is noted that the claims are, in a sense, product-by process claims insofar as the prepolymer is said to be "the reaction product of" (1) to (6). That is to say, the claims outline a list of starting materials from which the prepolymer is to be prepared thus implying a process. This is relevant because, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). It is the Examiner's position that, though a blocking agent separate of the diisocyanate reactant is not mentioned, it would still have been appropriate to reject under 102/103 had component (2) been taught because the blocking groups liberated from the diisocyanate prior to copolymerization of (1) to (5) remain in the system and would re-react with the

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prepolymer endgroups at the conclusion of the copolymerization. Hellwig even requires that 50% to 100% of the terminal isocyanate groups should be blocked.

*Zimmel et al.*, U.S. Patent # 6,660,376

Zimmel discloses a polyurethane hot melt adhesive comprising all of (1), (2), (4), (5), and the isocyanate reactive compound. As with Hellwig, blocking agents are added in the form of blocked polyisocyanates where the blocking agent is dissociated from the diisocyanate compound with heating prior to copolymerization.

Together Hellwig and Zimmel teach every component of the instantly claimed hot-melt adhesive. This is significant because the courts have held that, "it is prima facie obvious to combine two compositions, each of which is taught by prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." *In re Kerkhoven* 205 USPQ 1069. The idea for combining said compositions flows logically from their having been individually taught in the prior art. *In re Crockett* 126 USPQ 186, 188. See also *In re Shannon* 148 USPQ 504 (one step laminate is obvious from two step laminate). However, inasmuch as there is already an elastomeric component to Hellwig's prepolymer, it is not evident what precisely would have motivated one of ordinary skill to further incorporate a reactant corresponding to the polyurethane elastomer. Furthermore, it could not be ascertained why a quantity large enough to contribute 40 to 60% of the total weight of the prepolymer would have been incorporated. Indeed, even Zimmel favors adding only 10 to 30 weight percent of this component and replacing such a large amount of the polymer-forming materials in

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*Hellwig* with polyurethane elastomer would ostensibly radically change the properties of their prepolymer in ways that are not immediately evident.

These documents represent by far the most germane prior art available. Given their deficiencies as they pertain to an anticipation of the present invention, claims 1-13 are deemed allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

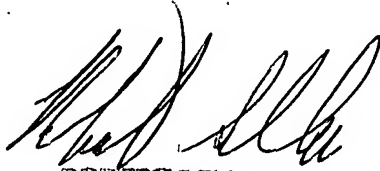
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 28, 2005



ROBERT SELLERS  
PRIMARY EXAMINER